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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/518,967

12/21/2004

Lewyn B. Boler JR.

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04/01/2008

SCHNADER HARRISON SEGAL & LEWIS, LLP

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SUITE 3600

PHILADELPHIA, PA 19103

EXAMINER

FEELY, MICHAEL J

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

04/01/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/518,967

**Applicant(s)**

BOLER, LEWYN B.

**Examiner**

Michael J. Feely

**Art Unit**

1796

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-32, 34 and 39-42 is/are allowed.
- 6) ☒ Claim(s) 1-17, 33 and 36-38 is/are rejected.
- 7) ☒ Claim(s) 35 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Pending Claims***

Claims 1-42 are pending.

***Terminal Disclaimer***

1. The terminal disclaimer filed on December 28, 2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Pat. No. 7,094,449 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Response to Amendment***

2. The rejection of claim 1-42 under 35 U.S.C. 112, first paragraph, has been overcome by amendment.
3. The rejection of claims 1-42 under 35 U.S.C. 112, second paragraph, has been overcome by amendment.
4. The rejection of claims 12 and 28 under 35 U.S.C. 112, second paragraph, has been overcome by amendment.
5. The rejection of claim 34 under 35 U.S.C. 101/35 U.S.C. 112, second paragraph, has been overcome by amendment.
6. The objection to the drawings has been overcome by amendment.
7. The objection to claims 1-35 and 37-40 has been overcome by amendment.

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8. The rejection of claims 1-42 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the combined limitations of claims 1-46 of U.S. Patent No. 7,094,449 has been overcome with a timely filed terminal disclaimer.

***Specification***

9. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the specification does not support *silicone* as a matrix material.

***Claim Rejections - 35 USC § 102/103***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 4-17, 33, and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Craig (US Pat. No. 6,033,464).

Regarding claims 1, 6, 7, 9-15, 33, and 36-38, Craig discloses a device for applying a protective coating to a subject surface comprising a composite (Abstract; column 2, line 35-61), said composite comprising:

- the instantly claimed matrix materials (column 3, line 41 through column 5, line 34);
- the instantly claimed silicone fluid (column 5, line 58 through column 6, line 49; product data for Dow Corning 593);
- the instantly claimed surface coating (column 6, line 50 through column 7, line 40); and
- the instantly claimed inert particles (column 7, line 40 through column 9, line 9).

The composite of Craig features variable amounts (*see column 5, lines 20-34*) of hard wax (*relating to the instantly claimed binder*) and variable amounts (*see column 7, line 15-25*) of soft wax (*relating to the instantly claimed surface coating*). The hard wax has a needle penetration value of about 40 mm or less at 25°C (*see column 3, lines 40-47*), and the soft wax has a needle penetration value of greater than about 40 mm at 25°C (*see column 6, lines 50-55*). Based on these variable amounts it appears that the composite of Craig would have inherently or obviously featured the instantly claimed *overall* needle penetration value. This is particularly the case when an excess of soft wax is obviously chosen by Craig.

Furthermore, it should be noted that the property limitations set forth in claims 9-15 and 38 would have been inherently satisfied by Craig because he satisfies all of the material/chemical limitation of the instant invention. In light of this, it has been found that, “Products of identical chemical composition can not have mutually exclusive properties.” A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure,

the properties applicant discloses and/or claims are necessarily present – *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Regarding claims 4, 5, 8, 16, and 17, it should be noted that all of these limitations are *optional*. Accordingly they are all satisfied by the composite of Craig.

### ***Claim Rejections - 35 USC § 103***

13. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Craig (US Pat. No. 6,033,464) in view of Currie et al. (US Pat. No. 6,184,330).

Regarding claims 2 and 3, Craig fails to explicitly disclose the inert particles set forth in these claims (*see column 8, lines 42-57*). Rather they disclose the use of an *extender type* filler.

The teachings of Currie et al. (*see column 8, lines 19-28*) demonstrate that the instantly claimed materials, and combinations thereof, are recognized in the art as equivalent extender fillers. In light of this, it has been found that the combining and substituting of equivalents known for the same purpose is *prima facie* obvious.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the instantly claimed inert particles in the composition of Craig because the teachings of Currie et al. demonstrate that these particles are recognized in the art as equivalent extender fillers.

***Allowable Subject Matter***

14. Claims 18-32, 34, and 39-42 are allowed.
15. Claim 35 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Communication*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Feely whose telephone number is (571)272-1086. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael J Feely/  
Primary Examiner, Art Unit 1796

March 31, 2008